

REMARKS

Claims 1-10, 12-23, 25-34, 36-38, 40, and 41 are pending in the present application. Claims 11, 24, 35, and 38 are canceled. Independent claims 1, 14, 28, and 38 are amended to incorporate limitations originally presented in claims 11, 24, 35, and 39, respectively. Claims 12, 13, 25, 26, 36, 37, 40, and 41 are amended to depend from claims 1, 14, 28, and 38. Reconsideration of the claims is respectfully requested.

Amendments were made to the specification to update the cross reference to the co-pending application.

I. Double Patenting

The Office Action rejects claims 1-41 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,687,819.

The Office Action provides a very review of the "major distinctions" between claims 1, 7, and 8 of the present application and claim 1 of the '819 patent. The Office Action then provides concludes as follows:

All of these are general statements from which a search operation may be inferred, and it would have been obvious to one of ordinary skill in the art at the time of the invention to formalize the identification operation as a search.

Office Action, dated 10 January 2005. The MPEP states:

A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

MPEP 804 II B.1. In other words, the Office Action must apply the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), for establishing a

background for determining obviousness when making an obvious-type double patenting analysis. The Office Action makes no such analysis other than to establish "major distinctions" and then to summarily dismiss them as obvious.

Nonetheless, the Office Action, in one fell swoop, rejects all of the pending claims without specifically addressing so much as a single claim. 37 § CFR 1.78(b) states:

(b) Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

37 CFR § 1.78(b). Applicants submit that the Office Action has not established any "conflicting claims." Applicants also assert that it is quite common for several commonly owned applications to be filed with common inventors. Typically, these applications will be in the same field of endeavor and, thus, have similar claims. However, the mere possibility of an obvious-type double patenting issue is not a basis for rejection.

Furthermore, a terminal disclaimer is not the only manner in which an obvious-type double patenting rejection may be overcome. Such a rejection may also be overcome by claim amendment. However, in this case, the claims have not been sufficiently analyzed to provide any guidance whatsoever as to how the claims could be amended. Certainly, it is possible that at least one of the forty-one originally filed claims recites a feature or combination of features not recited in the claims of the '891 patent.

Independent claims 1, 14, 28, and 38 are amended to incorporate limitations originally presented in claims 11, 24, 35, and 39, respectively. Applicants assert that the claims of the '891 patent do not recite at least selecting, by the boot code, one operating system of the plurality of operating systems, wherein selecting one operating system of the plurality of operating systems includes determining priorities of the plurality of operating systems and selecting an operating system having a highest priority, as originally filed in claims 11, 24, 35, and 39. The Office Action does not establish a *prima facie* case of obviousness for claims 11, 24, 35, and 39. Therefore, Applicants respectfully request withdrawal of the rejection under the judicially created doctrine of obviousness-type double patenting.

II. 35 U.S.C. § 102, Anticipation

The Office Action rejects claims 28, 38, 40, and 41 under 35 U.S.C. § 102(e) as being anticipated by *Madden et al.* (U.S. Patent No. 6,178,503). This rejection is respectfully traversed.

Madden teaches managing multiple operating systems on a single computer. More particularly, *Madden* teaches providing a boot management software program with boot-time graphical user interface and other features to present options to users with a simple and uniform interface for selecting the operating system and operating system mode to be booted. See *Madden*, col. 3, line 28, to col. 4, line 35.

Independent claims 28 and 38 are amended to incorporate limitations originally presented in claims 35, and 39, respectively. *Madden* does not teach or suggest least selecting, by the boot code, one operating system of the plurality of operating systems, wherein selecting one operating system of the plurality of operating systems includes determining priorities of the plurality of operating systems and selecting an operating system having a highest priority, as recited claims 28 and 38.

With respect to original claim 39, the Office Action states:

As to claim 38, the default choice [COL 1 lines 60-64] corresponds to selection of an OS with the highest priority. As to claims 40-41, the application of user choices by menu modifies the priorities.

Office Action dated 10 January 2005. The cited portion of *Madden* states:

In addition, the Boot Manager menu has a time-out. If one delays too long, Boot Manager boots according to a default choice. The NT menu also has a time-out, after which it boots NT. A user may have only a two-second window in which to hit the F8 key to get the six options presented by Windows 95/98.

Madden, col. 1, lines 60-64. The Technical Background section of *Madden* teaches various disparate boot management solutions. The Boot Manager solution for the OS/2 operating system includes a time-out, after which the boot manager boots according to a default choice. However, the Office Action proffers no analysis as to why this is equivalent to identifying a plurality of file systems on a storage device, each one of the plurality of file systems being associated with a partition of the storage device, identifying a plurality of operating systems associated with the plurality of file systems, each one of the plurality of file systems being associated with one or more of the plurality

of operating systems, determining priorities of the plurality of operating systems, and selecting an operating system having a highest priority, as recited in claims 28 and 38 (originally presented in claim 39). Applicants submit that simply booting a default choice is not equivalent to determining priorities of a plurality of operating systems for each one of a plurality of file systems and selecting an operating system having a highest priority.

The applied reference does not teach or suggest each and every limitation of claims 28 and 38; therefore, *Madden* does not anticipate the claims. Since claims 40 and 41 depend from claim 38, the same distinctions between *Madden* and the invention recited in claim 38 apply for these claims. Additionally, claims 40 and 41 recite other additional combinations of features not suggested by the reference.

Therefore, Applicants respectfully request withdrawal of the rejection of claims 28, 38, 40, and 41 under 35 U.S.C. § 102(e).

III. 35 U.S.C. § 103, Obviousness

The Office Action rejects claims 1-10, 12-23, 25-27, 29-34, 36, and 37 under 35 U.S.C. § 103(a) as being unpatentable over *Madden*. This rejection is respectfully traversed.

Independent claims 1 and 14 recite subject matter addressed above with respect to claims 28 and 38 and are allowable for similar reasons. Since claims 2-10, 12, 13, 15-23, 25-27, 29-34, 36, and 37 depend from claims 1, 14, and 28, the same distinctions between *Madden* and the invention recited in claims 1, 14, and 28 apply for these claims. Additionally, claims 2-10, 12, 13, 15-23, 25-27, 29-34, 36, and 37 recite other additional combinations of features not suggested by the reference.

Therefore, Applicants respectfully request withdrawal of the rejection of claims 1-10, 12-23, 25-27, 29-34, 36, and 37 under 35 U.S.C. § 103(a).

IV. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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